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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,316	03/19/2001	Bruce M. Young	10004460-1	3773

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EXAMINER

GEREZGHER, YEMANE M

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/814,316	Applicant(s) YOUNG ET AL.	
	Examiner Yemane M Gerezgiher	Art Unit 2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been examined. Claims 1-32 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 11-14 and 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mandalia et al (U.S. Patent Number 5,907,598) hereinafter referred to as Mandalia in view of Chang et al (Publication Number USS 20030095542 A1) hereinafter referred to as Chang and further in view of Matsubayashi (EP 1109113 A2).

As per claims 1, 12, 20 and 21 Mandalia disclosed method providing a facsimile service receiving a facsimile sent to a telephone number; responsive to receiving the facsimile: See ABSTRACT. Mandalia disclosed *converting the facsimile from a fax format to a printable data format; wrapping the converted facsimile in a network transfer protocol language*; See ABSTRACT ("receive facsimile (fax) telephone transmissions, convert them to HTML (Hypertext Markup Language) web page format") Column 5, Lines 15-45 ("The received signals are converted by the fax server to a format suitable for presentation over the external data network; e.g. to HTML (Hypertext Markup Language) format suited for presentation on the web and forwarded to a web server

managed by the AIN intelligence..." and Column 2, Lines 14-50 (Mandalia taught receiving a facsimile (fax message sent to a receiving entity and where the facsimile message was converted to a printable format of HTML using a HTTP protocol (claims 2, 13 and 24) where the printable data format could be of any well known and widely used formats such as PDF, GIF, JPEG (claims 3, 14 and 25). Mandalia disclosed *identifying a Universal Resource Locator (URL) that corresponds to the telephone number, where the URL identifies the web server*. See Column 5, Lines 15-67. Mandalia disclosed the conversion of data format from a facsimile to a printable HTML format performed by POP provider (claims 4-6). See Figure 2. Mandalia substantially disclosed the invention as claimed. However, Mandalia was silent about embedded web server in a printer.

An artisan working with Mandalia invention at the time of the invention would have been motivated to look for teaching that may have allowed a printer to function as device for receiving a facsimile (fax). In these arts, Chang disclosed a pseudo fax/phone number defined to uniquely identify a printer and "once a printer is assigned a pseudo fax number, the printer can receive faxes sent to that pseudo number just like a fax machine. The fax gateway in the called gateway server converts the received fax into a printable form before sending the received fax to print..." See Page 22, Paragraph [0237]. Chang disclosed a printer receiving a facsimile converted in to a printable format and being sent to the printer to be printed.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Chang related to converting a facsimile/fax format to a printable format and printing the converted document from the printer and

have modified the teachings of Mandalia related to converting a facsimile document transmitted from a PSTN to a HTTP based network document of nature HTML or XML, because "this feature allows the simultaneous transmission and receipt of faxes between company sites without busy signals. It also supports the use of plain paper for printing faxes" See Page 22, Paragraph [0237]. However, Chang was also silent about EWS (embedded web server) in a printer

As evidenced by Matsubayashi, EWS (embedded web server) in a printer was well in the art at the time of the invention. Matsubayashi disclosed a method for providing a web page from a service provider implemented on a printer (a printer's EWS), receiving a printable document corresponding to the URL and printing the retrieved document (See ABSTRACT Column 2, Lines 17-50 and Column 5, Lines 41-56). An embedded web server in a printer receiving a request for printing a web page associated with the URL. See Column 6, Lines 51-57, Column 11, Lines 1-30 and Figure 5.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Matsubayashi related to EWS (embedded web server) in a printer (multifunctional device) and have modified the already combined teachings of Chang and Mandalia related to converting a facsimile/fax transmitted from a PSTN to a HTTP based network document format to a printable format and printing the converted document from the printer, in order to optimize network processing time and bandwidth associated with transmission of the printable document.

4. Claims 7-10, 15-18 and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mandalia et al (U.S. Patent Number 5,907,598) hereinafter referred to as Mandalia in view of Chang et al (Publication Number USS 20030095542 A1) hereinafter referred to as Chang in view of Matsubayashi (EP 1109113 A2) and further in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made.

The combined teachings of Mandalia, Chang and Matsubayashi substantially disclosed the invention as claimed. However, the combined teachings did not explicitly mention receiving a message from a web server, the message corresponding to a status of the communicated facsimile indicating success or failure of the communicating and the conditions of the printer functionality using e-mail address or a URL. However, these futures were well known in the art of computer networking at the time the invention was made.

Thus, the Examiner takes Official Notice (see MPEP § 2144.03) that "receiving a message from a web server at an address such as an email address, corresponding to a status of the communicated facsimile from a printer serve/ web server" in a computer networking environment was well known in the art at the time the invention was made. For example U.S. Patent Number 6,711,154 issued to O'Neal disclosed an apparatus and method for a user upon a receipt of selected messages. **"Messages are converted into a format compatible with a data network for delivery to a web server. The web server includes a message notification system with message**

Art Unit: 2144

alert type selection and incoming message filtering. A user designates, either from a computer, or from a telephone, the types of messages for which s/he wishes to be alerted, and designates one or more device types (email address, fax machine, pager number, or telephone number) to receive the alert. When messages are received by the web server, they are distinguished by message type, and filtered according to the user-defined criteria. Selected messages cause a message alert to be generated to the user configured devices." (See ABSTRACT and Figure 4). Further, Champaman et al. (U.S. Publication Number 2002/0057449 A1) disclosed **a method and apparatus for automatically communicating status information relative to a document production job by a printer** (See ABSTARCT and Figure 2). The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the commonly used teachings related to receiving a message from a web server or a printer, the message corresponding to a status of the communicated facsimile indicating success or failure of the communicating and the conditions of the printer functionality using e-mail address or a URL and have modified the already combined teachings of Mandalia, Chang and Matsubayashi related to converting a facsimile document in to a printable document and sending the converted printable document to a web server embedded in a printer in order to determine the condition of a remotely located printer with regards to a communicated facsimile document.

5. Claims 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubayashi (EP 1109113 A2) in view of Mandalia et al (U.S. Patent Number 5,907,598).

As per claims 31 and 32, Matsubayashi disclosed a system for retrieving and printing network documents using a printer comprising an embedded web server for providing a web page from a service provider and receiving a printable document corresponding to the URL and printing the retrieved document (See ABSTRACT Column 5, Lines 41-56 and Column 2, Lines 17-50). An embedded web server in a printer receiving a request for printing a web page associated with the URL. See Column 6, Lines 51-58 and Figure 5. Matsubayashi disclosed the EWS (embedded web server) retrieving the corresponding document and printing the printable HTTP based

document. See Column 8, Lines 4-51. Matsubayashi substantially disclosed the invention as claimed. However, Matsubayashi did not teach a fax message having been converted from a facsimile format to a printable format.

However, as evidenced by the teachings of Mandalia, converting a fax message from a facsimile format to a printable format of multiple printer formats was well known in the art at the time the invention was made. Mandalia disclosed method providing a facsimile service receiving a facsimile sent to a telephone number; responsive to receiving the facsimile: See ABSTRACT. Mandalia disclosed *converting the facsimile from a fax format to a printable data format; wrapping the converted facsimile in a network transfer protocol language*; See ABSTRACT ("receive facsimile (fax) telephone transmissions, convert them to HTML (Hypertext Markup Language) web page format") Column 5, Lines 15-45 ("The received signals are converted by the fax server to a format suitable for presentation over the external data network; e.g. to HTML (Hypertext Markup Language) format suited for presentation on the web and forwarded to a web server managed by the AIN intelligence..."). Thus it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings Mandalia related to converting a fax message from a facsimile format to printable format and have modified the teachings of Matsubayashi related to a printer having an embedded web server for printing printable documents, in order to enable the printer to receive messages that are suitable to be printed.

Conclusion

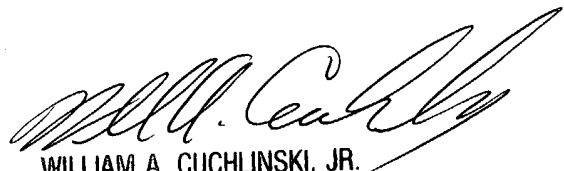
6. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

- a. Lippert, Lisa M. et al (US 6626957 B1) entitled: *Markup language content and content mapping*
- b. Chang, Jack H. et al. (US 20030018720 A1) entitled: Apparatus and Method for providing Multimedia Messaging between Disparate Messaging Platforms
- c. Henry, Matthew K. (US 6424426 B1) entitled: *Fax-to-email and email-to-fax communication system and method*
- d. Fu, Arron et al. (US 20020018234 A1) entitled: *Printer driver system for remote printing*
- e. Bloomfield, Mark C. (US 6023345 A) entitled: *Facsimile to E-mail communication system with local interface*

7. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Yemane Gerezgiher whose telephone number is 703-305-4874. The examiner can normally be reached on Monday- Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful. The examiner's supervisor, William Cuchlinski, can be reached at (703) 308-3873.

Yemane M. Gerezgiher
TC 2100, AU 2144


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